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OFFICE OF PETITIONS

In re Application of
Pinchuk, et al.
Application No. 09/657,041
Filing Date: 5 September, 2000
Attorney Docket No. BSI-430US8

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DECISION ON PETITION

This is a decision on the petition filed on 26 August, 2004, alleging, *inter alia*, unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates:

- the application was filed on 5 September, 2000, and, in the Office action of 2 July, 2003, the Examiner found that the re-issue application had been filed without, *inter alia*, a valid and fully executed oath or declaration because the oath/declaration filed failed “to identify at least one error which is relied upon to support the reissue application”; and
- a Supplemental Reissue Declaration filed with an amendment on (or about) 6 October, 2003 (over a 1 October, 2003, Certificate of Mailing), was unsigned and Petitioner’s reply filed on 11 December, 2003 (without a request and fee for extension of time), included and oath/declaration that was not a valid fully executed oath/declaration and no petition under 37 C.F.R §1.47) was filed at that time;
- therefore, the application appears to have gone abandoned after midnight 1 October, 2003;

- no Notice of Abandonment was mailed by the Office;
- a petition under 37 C.F.R. §1.47 was filed via FAX on 9 February, 2004, after the instant application went abandoned, and was not accompanied by a petition (with fee) to revive the application as abandoned due to unintentional delay (under 37 C.F.R. §1.137(b)), and further the petition referenced, *inter alia*, an oath/declaration signed by named inventors save for Rysler Alcime (Mr. Alcime); and a declaration by Petitioner Jonathan H. Spadt (Reg. No. 45,122), and a copy of a letter from Petitioner to the non-signing inventor Mr. Alcime, however the copy of the letter to Mr. Alcime indicates that only the oath/declaration—and not the entire application (description, claims, drawings)—was sent to Mr. Alcime; thus the petition under 37 C.F.R. §1.47 was dismissed on 9 December, 2004;
- the instant petition under 37 C.F.R. §1.137(b) (with fee) was filed on 7 January, 2005, and was accompanied by a renewed petition under 37 C.F.R. §1.47 and supporting documents therefor.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

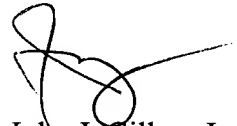
Petitioner has satisfied the petition, fee, reply and statement/showing requirements of the regulation.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is released to OIPE for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
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Office of Petitions

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.